



PATENT
BRENDA 5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Brenda Pomerance Confirmation: 7218
Filed: April 5, 2000 Art Unit: 2161
Serial No.: 09/543,049 Examiner: J. Hayes
Title: AUTOMATED ALTERNATIVE DISPUTE RESOLUTION

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: April 15, 2005

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**REPLY BRIEF
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is responsive to the Examiner's Answer, mailed February 15, 2005.

The Examiner's Answer is replete with instances of the following three errors, discussed herein:

- The Examiner's view of "one of ordinary skill in the art" is flawed;
- The Examiner repeatedly argues that applicant resorts to unsubstantiated argument, rather than providing basis for his rejection; that is, the Examiner's obviousness rejections amount to "because I say so"; and
- The Examiner states that applicant argues limitations not recited in the claims whenever applicant provides perspective on the claims; that is, applicant has carefully argued the claims on their merits only, and Examiner attempts to muddy this clarity rather than explain why applicant is wrong.

In the interests of brevity, only a few examples are provided to illustrate these points. If the Board wishes, applicant will be happy to make a detailed listing of each instance of the Examiner's Answer demonstrating one of these three errors.

ONE OF ORDINARY SKILL IN THE ART IS SKILLED IN ONLY ONE ART

This invention relates to automated dispute resolution. The invention spans two "arts": dispute resolution and a computer system for interacting with a human.

If one of ordinary skill in the art is a dispute resolver, then, at the time the application was filed, it must be acknowledged that ordinary dispute resolvers believed that their ability to manage a dispute was a uniquely human capability involving their sensitivity to the disputants' emotional states as well as their ability to inject authority into the dispute by getting dispute resolvers to follow the dispute resolution process. See Declarations of Kallas and Femenia. Dispute resolvers simply could not fathom that they could be replaced by a computer. Applicant, who is trained as both a dispute resolver (New York Small Claims court arbitrator) and a computer engineer, realized that for simple disputes, a computer can probably do as well as a mediocre to average dispute resolver. However, applicant is one of extraordinary skill by bridging *two* arts.

If one of ordinary skill in the art is a computer designer, then s/he would be unfamiliar with dispute resolution as a topic. The ordinary computer designer does not understand how to manage dispute resolution, and would not be motivated in the way that the Examiner argues, as the ordinary computer designer lacks the lens of the present invention for viewing the two types of art that the Examiner has relied on: Sloo's bulletin board system for complaints, and the human-guided art of Online Resolution and Eisen.

Sloo's disclosure supports this point. Sloo discloses:

- an anonymous complaint posting system; and
- an anonymous email method for direct negotiations – but this is merely a facility for a complainer to send email – using an anonymous account created only for this purpose – to a complaine, and hope that the complaine will respond and therefore the complainer will be encouraged and provide his/her name.

Sloo does not teach a computer system that enables a vendor to program the system with its complaint handling policies, so that the system can then guide complainees through a process of obtaining a remedy, including emotional venting that is so important to a good resolution.

The Examiner ignores the fact that one of ordinary skill in the art of either dispute resolution or computer design is not presumed to have skill in the other of the arts, and thus cannot behave as the Examiner asserts.

Examples of this error can be found in the Examiner's Answer at: paragraph bridging pages 6-7 (emotions are a big part of the dispute resolution process to a dispute resolver); page 8

(a computer designer, faced with Sloo's system, would not have the skill of a dispute resolver to add emotions), and so on.

THE EXAMINER'S "UNSUBSTANTIATED ARGUMENT" ATTACK IS AS A FLAG FOR LACK OF EXAMINER'S SUBSTANTIAL ARGUMENT

The Examiner bears the burden of proof in making an obviousness rejection. When applicant points out that the Examiner has not carried his burden, the Examiner answers that applicant is making unsubstantiated argument. However, this leaves Examiner's burden still unmet.

Examples of this error can be found in the Examiner's Answer at: page 18 issue 5 (Brownwell talks about interpersonal skill, and the Examiner fails to explain why a teaching relating to interpersonal skills is relevant to a computer system); page 18 issue 2A (Examiner discusses Eisen, but still leaves unaddressed the issue of the impropriety of changing Sloo from an anonymous system to a non-anonymous system), and so on.

PROVIDING CONTEXT IS NOT ARGUING A CLAIM LIMITATION

The teachings of a reference must be viewed in context. It is improper to seize upon a phrase or thought in a reference and use it out of context; this is unwarranted redesigning of the prior art with no motivation. Whenever applicant provides the context for a reference or claim, the Examiner asserts that unrecited limitations are being argued. Not so. When the Examiner cherry-picks a reference using the lens of the present invention, the result is an improper obviousness rejection.

Examples of this error can be found in the Examiner's Answer at: page 16 middle (Examiner pulls the teachings of Online Resolution and Eisen out of their mediation/arbitration context, as directed by the dispute resolver, and asserts it applies to all dispute resolution independent of whether the dispute resolver is there to manage emotions); page 18 top (Examiner says that explaining that Eisen is directed to a mediator is arguing a limitation that is not recited, but the claims are to steps that are automatically performed by a computer, and thus could not be claiming what is done by a mediator), and so on.

ADDITIONAL ERRORS

All references are to pages in the Examiner's Answer.

At page 5, bottom paragraph, the Examiner argues the complaint handling policy is merely nonfunctional descriptive matter. Not so. A previously provided complaint handling

policy is akin to a particular electrical signal that is provided in response to certain circumstances.

At page 10, “claim 49” paragraph, Examiner states that Brownwell indicates that the ability to communicate effectively is a key interpersonal skill – but then fails to explain why a computer should be endowed with a personal skill.

At paragraph bridging pages 10-11, Examiner invents a motivation (to ensure the complaint is resolved) – but Sloo doesn’t care about this, Sloo just wants people to post complaints publicly as a sort of shame barometer for companies.

At page 17, middle paragraph, the Examiner sounds the alarm that should the present claims be allowed “then anyone could continue indefinitely patenting a method for resolving disputes similar to Sloo provided that they add new or different information in the complaint” – but (1) Sloo is concerned with *posting* complaints, not resolving them; for resolution, parties are merely given email access to each other; and (2) patentability is limited by what is not in the prior art; if other people think of other variations on Sloo, they might be patentable and there is nothing wrong with numerous patents on dispute resolution systems, or televisions, or mobile phones, or semiconductors or any other art.

At page 17, bottom paragraph, Examiner “submits that just because Eisen states that online mediation may be difficult for various reasons, does not necessarily mean that it is impossible or shouldn’t be attempted.” Eisen doesn’t merely state that online mediation might be difficult, he says it is “no substitute” (bottom of page 1), “would create communication breakdowns” (top of page 2), “is an unwise idea” (middle of page 2), “has serious limitations” (page 5, second paragraph), “could not accomplish [engaging the parties in a therapeutic conversation]” (page 5, fourth paragraph), lacks the “impetus of the face-to-face conversation” (page 6, bottom), “would require nothing less than a reinterpretation of the profession [of dispute resolution]” (page 7, third paragraph), and so on.

For the reasons discussed above, in addition to those in the Brief, the Board should allow all of the pending claims.

Respectfully submitted,

Date: April 15, 2005

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